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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,037	04/07/2004	James T. Mihm	42P19143	9251

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EXAMINER

PATEL, HARESH N

ART UNIT	PAPER NUMBER
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2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/821,037	MIHM ET AL.	
	Examiner	Art Unit	
	Haresh Patel	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-37 are subject to examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of Autry, U.S. Patent No. 6,990,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent discloses all the limitations as disclosed such that the interpretation of the claimed automatic firmware image recovery is similar to the steps of the claims of the patent that are not manual, i.e., receiving, comparing, etc. The claimed subject matter of claims of the patent does not specifically mention about usage of baseboard management controller. However, the usage of baseboard management controller is well known in the art, for example, Do, 6,367,007, discloses the baseboard management controller, table 1, col., 4; Intel, www.intel.com/design/servers/imp/imp_i also discloses the usage of the baseboard management controller with Intelligent Platform management interface (IPMI), 8/16/2008, pages 1-6.

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Lancewood Server, Baseboard Management Controller, November 24, 1999 also discloses the well-known usage of the BMC, pages 1-3. With the well-known usage of the controller it would be obvious to one of ordinary skill in the art to include the concept of using the controller with the claimed subject matter of the claims of the Autry, U.S. Patent No. 6,990,577. The motivation is that the usage of controller supports communicating multiple entities for sending and receiving information among the entities.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim".

In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); **In re Bern, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998)** (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " **ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending application, Mihm et al., U.S. Publication No. 2005/0228888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application discloses the limitations as disclosed such that the interpretation of the claimed automatic firmware image recovery is similar to the automatic firmware image recovery of the co-pending application. The claimed subject matter of the claims of the copending application does not specifically mention about usage related to BIOS/firmware. However, the usage related to BIOS/firmware is well known in the art. With the well-known usage of the BIOS and the BIOS related firmware it would be obvious to one of ordinary skill in the art to include the concept of using the BIOS/BIOS firmware with the claimed subject matter of the claims of the copending application. The motivation is that the BIOS utilize a firmware, which when require update/replacement, and the usage of the automatic firmware image would support the update/replacement.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title, i.e., "Automatic

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Firmware update proxy” is too broad and is not sufficient for proper classification of the claimed subject matter.

Drawings

5. The figures submitted on 4/7/2004 are acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Claim 1 and its dependent claims claimed subject matter for automatic firmware image recovery, which contain a determining step to replace a firmware image, however, until the firmware image which is used for the determining is replaced the steps of the claimed invention do not produce a concrete and tangible result, which enables any usefulness of having done the determining to be realized (please see the claimed subject matter of claim 1). Similar applies to claims 8, 14, 16, 20, 26, 35 and their dependent claims. Also, claims 8, 14, contain a machine accessible medium, which can be a carrier wave that encodes a data signal and that is not statutory as it does not fall into any of the categories of the statutory subject matters.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and its dependent claims rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Step replacing the firmware image which is used by the determining step, the compatible image of the system, step 209, figure 3, related/linked/relationship between the request message that is received for the same image, step 251, figure 3, sending a response to the recipient, steps 211, 257, determination of whether the recipient accepted, step 259, uploading the requested BIOS image step 261, downloading the sent compatible image step 213, and selecting step to select the donor system are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is not possible to recover/replace the firmware image without these steps, which are supported by the figure 3 of this application under prosecution. It is not possible to use unrelated images (without “the” or “said”) for recovering a single image of the BIOS. It is not possible to have the messages (acknowledgement, etc) that not related/linked/relationship with each other. Similar applies to claims 8, 14, 16, 20, 26, 35 and their dependent claims.

Claims 16, 26 and 35, its dependent claims rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Usage of proxy in the claimed steps is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the

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disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is not possible to “automatic firmware image update (by) proxy” (see body of claim 35 for clarification) without usage of the proxy by the steps of the claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Following claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and its dependent claims recite the limitations, “negotiating with a donor system based on a received acknowledgement that the donor system has a compatible image” are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not apparent what negotiating is done with the donor system as the acknowledgement is already received from the donor system for the compatible image, which is contrary to the negotiating. Similar applies to claims 8, 15, 16, 21, 31 and their dependent claims.

Claim 1 and its dependent claims recite the limitations, “a set of at least one donor system”, are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). “a set” is contrary to “at least one”. Similar applies to claims 8, 21, 31 and their dependent claims.

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The term "compatible" in Claims 1, 8, 14, 16, 20, 26, 35 and its dependent claims is a relative term, which renders the claim indefinite. It is not apparent to what the compatible refers to.

Claim 2 and its dependent claims recite the limitations, "uploading a compatible image to the recipient system", are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not clear how the uploading of claim 2 regarding the negotiating is related to the uploading of claim 1, as the figure 3 clearly demonstrates that only one uploading for the replacement/recovery is necessary.

Claim 26 recites the limitation "the recipient system BIOS firmware". There is insufficient antecedent basis for this limitation in the claim.

Claim 35 and its dependent claims recite the limitations, "processor on a computer system", "needs be" are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d).

Claims 16, 26, 35 recite the limitations "automatic firmware image update proxy" that are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). See claim 35, which states, "firmware image update by proxy", which is not what the claims represent.

Claim 2 mentions, "system on the network", however, the system cannot exist on the network. (similar applies to respective claims that contain these limitations.

Appropriate correction is required.

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Note: claim 2, contain usage of “if” which is not same as “when”. (hence, the limitations related to the “if” are optional).

Note: Regarding the applicant’s usage of “wherein” and/or “whereby” in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Please see **Minton v. Nat ’l Ass ’n of Securities Dealers, Inc.**, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Haresh Patel

February 13, 2007